

First Named Inventor	Andrew L. DiRienzo	<p style="text-align: center;">PRE-APPEAL BRIEF REQUEST FOR REVIEW</p>
Serial No.	09/439,343	
Filing Date	November 15, 1999	
Group Art Unit	2164	
Examiner Name	Sana A. Al Hashemi	
Confirmation No.	1539	
Attorney Docket No.	236.003US02	
<p>Title: SYSTEMS FOR RECEIVING AND FORMING MARKETPLACES FOR WORKING ON DIGITAL INFORMATION BLOCKS</p>		

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In response to the Final Office Action mailed March 17, 2008, please consider the following in the Pre-Appeal Brief Request for Review:

REMARKS

Appellant contends that the rejections of the Final Office Action (FOA) are premised on invalid assertions, several of which are directly contradictory to the teachings of Appellant's Specification. As a result, Appellant submits that these invalid assertions constitute clear error. Accordingly, Appellant contends that that each of the rejections is unsupported by the record. Although Appellant's citations to its Specification will be to the Substitute Specification as filed on December 11, 2000, Appellant notes that the cited text appears in the Specification as originally filed on November 15, 1999.

With regard to claims 103 and 107, the FOA asserts, "Claim 103 has been amended to recite '...wherein each of the links is associated with a single one of the digital information blocks.' This feature is not taught or supported in the original specification. The only discussion of relations between links and information are set forth at pages 26 and 27." FOA, page 2, second to last paragraph (emphasis added) (same rationale applied to claim 103 was applied to claim 107: FOA, page 3, fifth paragraph). Appellant contends that this assertion is clearly unsupported by the record as the cited portions are NOT "the only discussion of relations between links and information." There are other sections of the Specification that discuss different relations between links and information. And, it is these additional sections of the Specification that support the claim wording. For example, on pages 38 – 41 of the Specification, the Document Control Number (DCN) is an example of a link, the Electronic Medical Record (EMR) is an example of a digital information block, and a Patient Bid Queue (PBQ) is an example of a list of links. This section of the Specification expressly teaches the element of claims 103 and 107 that a link is associated with a single digital information block through at least the following statements:

1. "The Patient Bid Queues (PBQs), in an exemplary case, are computer directories of Electronic Medical Records (EMRs)" Specification, page 38, last paragraph.
2. "the contents of the PBQs and PMBs can be pointers, links or shortcuts to the actual EMRs containing the EMIs to be read." Specification, page 39, last paragraph.
3. "The operating software of the CHC 200 then places the Document Control Number corresponding to the patient's EMR in the appropriate Patient Bid Queue (PBQ) or Provider Mail Box (PMB)." Specification, page 41, second paragraph.

4. “By highlighting or selecting the DCN for his/her EMR, the patient will be able to determine the relative velocity of his/her EMR through the selected PBQ or PMB.” Specification, page 41, third paragraph.

Thus, Appellant contends that there is clear support for the association of a link with a single one of the digital information blocks.

The FOA further asserts that the quotes from pages 26 and 27 of Appellant’s Specification support only a link to plural information blocks, and not a link to a single information block. FOA, page 3, third paragraph. While Appellant acknowledges that the two sentences quoted by the FOA may not fully address the subject matter of claim 103, Appellant contends that the Specification as a whole must be considered for its teachings, and that Appellant cannot be limited to the disclosure of only the two quoted sentences. *Cf.* MPEP § 2164.06(c) (“the reasons for finding the specification to be nonenabling should be supported by the record as a whole”). As noted above, the Specification provides details of one example embodiment where a link, e.g., a Document Control Number, is associated with a single digital information block, e.g., a patient’s Electronic Medical Record. Because the Specification at page 41, third paragraph provides, “By highlighting or selecting the DCN for his/her EMR, the patient will be able to determine the relative velocity of his/her EMR through the selected PBQ or PMB,” Appellant contends that there is support for a single link, i.e., the DCN, associated with a single digital information block, i.e., the EMR, as there is no reasonable interpretation of this action that would permit one link, i.e., the DCN, to be associated with more than one of the digital information blocks, i.e., the EMRs. Appellant further contends that there is additional clear support for a DCN being associated with a single EMR. *See, e.g.,* Specification, page 33, first paragraph (“Finally, a Document Control Number (DCN) is assigned to the patient’s EMR, which advantageously allows the patient/gatekeeper, the diagnostic physician performing the reading, and the operating system of the CHC 200 to follow (track) and access the EMR as it moves through the RAMIX system.”).

The FOA further asserts, “However, since the specification never invokes or otherwise defines the term ‘information block’, and since distinct plural images would only suggest plural information blocks, the disclosure only suggests a link to plural information blocks, not a link to a single information block.” FOA, page 3, third paragraph. Appellant contends this is yet

another invalid assertion. Appellant contends that the recited term “digital information block” was indeed invoked by the Specification as filed. *See*, Specification, page 14, last paragraph – page 15, first paragraph (“These and other objects, features and advantages according to the present invention are provided by a buffer memory for storing a plurality of digital information blocks generated by a plurality of respective first users in an order established by the first users and reflecting time of arrival, wherein each of the digital information blocks is receivable by at least one of a plurality of second users, wherein each of the digital information blocks includes an indicia of the priority one of the first users attaches to an associated one of the digital information blocks, and wherein one of the second users elects to receive one of the digital information blocks responsive to the indicia of a respective digital information block.”). While Appellant may not have expressly defined the term “digital information block,” Appellant contends that it has provided examples of such digital information blocks. For example, page 14, last paragraph of the Specification recites, “buffer memory for storing a plurality of digital information blocks” while page 38, first full paragraph of the Specification recites, “actual medical records [EMRs] advantageously can be stored in a buffer memory.” Similarly, page 15, first paragraph of the Specification recites that the digital information blocks are, “in an order established by the first users and reflecting time of arrival” while page 38, first full paragraph recites that the EMRs are, “shown in a consolidated listing sorted on the bid price offered for the reading and the date-time the EMR containing the EMI is received.” Thus, Appellant contends that there is clear support that EMRs are examples of digital information blocks recited in Appellant’s claims. In addition, even without an express definition as to the meaning of the term “digital information block,” the term is entitled to its ordinary and customary meaning attributed by those of ordinary skill in the art. MPEP § 2111.01. Appellant contends that the Office has provided no purported ordinary and customary meaning for a block of digital information that would require multiple images as asserted by the FOA.

The FOA further asserts, “Additionally, claim 177 recites the action of recording when as [sic] link has been used and to record when an information block has been downloaded. The original specification contains no discussion of recording link usage or block downloading in any manner of record, so this feature is additionally found to be new matter.” FOA, page 3, last paragraph. Again, Appellant contends that this assertion is invalid. The Specification, page 44,

first paragraph provides, “The diagnostic physician selects the first DCN in the list. This selection results in several simultaneous actions in CHC 200. First, all of the other diagnostic physicians reviewing the same PBQ are locked out of the EMR having the selected EMI. . . . When the diagnostic physician does not wish to read the currently previewed EMI, the diagnostic physician rejects the EMI and the DCN is deselected; thus, the other diagnostic physicians are no longer locked out of the rejected EMI.” The Specification, page 37, second paragraph further provides, “It will be appreciated that the contents of Table 1 are changing continuously as images come in from patients and are downloaded by the diagnostic providers.” Thus, the concept of recording when a link has been used and when a digital information block has been downloaded is supported by the Specification as filed as it would be inherently impossible to lock out an EMR in response to selection of a DCN without recording its selection or to update a table in response to downloading an EMR without recording that the EMR was downloaded.

With regard to claims 152 and 174, the FOA asserts, “Each of these claims calls for action of ordering a list by using electronic labeling. The mere presence of a label (i.e. text) on an electronic item will not result in that item being ordered into a list. Additionally, a ‘label’ is a not [sic] parameter which could be used to determine the order of items in a sequential list. Accordingly, the invention is inoperable as claimed.” FOA, page 4, third paragraph. Appellant contends that this assertion is clear error. Appellant contends that ordering lists by other than numeric parameters has been widely understood and well known far before Appellant’s filing date. Appellant submits that a common phone book is an example of a list ordered by a label, i.e., the customer names. In addition, Appellant contends that it expressly contemplated ordering lists using electronic labeling at the time of filing. *See, e.g.*, Specification, page 15, first full paragraph (“to arrange the electronic medical images in an order established by the electronic labeling of the electronic medical images”).

With regard to claims 156 and 170, the FOA asserts, “Claims 156 and 170 specify the actions of selecting a link, downloading an information block and taking some un-defined action in order to render payment for a bid. Payment requires a transfer of funds between two parties. Since these steps do not make any requirement for a transfer of funds, much less a transfer of funds between two parties, the payment action is not accomplished. Accordingly, the invention as claimed is inoperable.” FOA, page 4, fifth paragraph. Appellant contends that this reason for

rejection is itself invalid. The Office has defined payment to be a transfer of funds between two parties, yet declares the invention as claimed inoperable for not reciting a transfer of funds to effect payment of the bid amount. Using the Office's own definition of payment, Appellant contends that as the claims recite "the bid amount is paid," a transfer of funds is inherent, and thus the invention as claimed in claims 156 and 170 is necessarily operable in contradiction to the Office's assertion. Cf. MPEP § 2173.05(e) ("Inherent components of elements recited have antecedent basis in the recitation of the components themselves.").

In view of the foregoing, Appellant contends that each of the rejections is premised on one or more invalid assertions such that none of the rejections are supported by the record. Accordingly, Appellant contends that the rejections must be withdrawn.


CONCLUSION

In view of the above remarks, Appellant believes that all pending claims are in condition for allowance and respectfully requests a Notice of Allowance be issued in this case. Please charge any further fees deemed necessary or credit any overpayment to Deposit Account No. 501373.

If the Review Panel or the Examiner has any questions or concerns regarding this application, please contact the undersigned at (612) 312-2204.

Respectfully submitted,

Date: 16 SEP 08



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